

application so that a multiple application process with multiple fees and multiple responses had to be pursued. I really tip my hat to KAUFMAN and his attorney.

Applicant's attorney continues to respectfully traverse examiner's opinion that KAUFMAN is proper prior art to the Beckman/Perez process patent application. KAUFMAN may show the state of the art that is vastly improved by the solution to a desired problem shown in KAUFMAN – how to use a vending machine in such a manner as to increase the marketing and attraction of the vending machine. Most vending machines just stand there waiting to be found. This machine is shown to have attractive advertising and to promoting gambling.

Reading of KAUFMAN shows the claims of the patent do not guarantee that upon deposit of the required sum of money to dispense something from the machine that the item dispensed will be a promotional item. The claims require the machine to be loaded with the product and “at least one promotional item”. There is no requirement that the machine be loaded with a one to one corresponding product and promotional item in any of the claims.

Looking closely first at the promotional item and then at the product:

PROMOTIONAL ITEM

KAUFMAN uses an empty beverage container for the packaging of the promotional item. The beverage container is split vertically in one embodiment and horizontally in another embodiment. If there were any beverage in the beverage container the beverage is completely compromised. If splitting the container did not compromise the beverage containing ability of the beverage container to contain a beverage, KAUFMAN teaches stuffing the split, empty beverage container parts with the T-shirt that is first compacted, under sever pressure into the beverage container shape but smaller than the beverage container into which it is to be stuffed. This leaves no room for beverage or snack in the container. The split container is then taped closed with the label, tape or with shrink wrap so that the T-shirt does not fall out of the split container. The now filled promotional container is mounted into at least one slot of the vending machine. KAUFMAN does not impose a requirement that there be a one to one correspondence for mounting one promotional item each time a product item is mounted into the vending machine. KAUFMAN expressly teaches a correspondence of 1-5 or as high as 1-100 of the promotional item to the product item in the vending machine.

The promotional item is packaged in a container similar to the beverage container. In this manner, the vending machine may be maintained by filling the vending machine with product and at least one promotional item without reduced chance of any item becoming jammed in the machine.

The gambling may now begin according to the teaching of the patent. Without a requirement that there be a one to one correspondence of product and promotional item loaded into the vending machine there is no assurance to the user of the machine that upon depositing the required sum of money and punching the dispense button that a promotional item will be dispensed.

If the user wins a promotional item the teaching of the patent is to stuff money or a coupon into the promotional item so that upon unpacking the promotional item the user can then use the money in a second insertion of money and a second selection of an item to purchase the product. If the user has the promotional item in his hand and the return of money the user just put into the machine, what would now entice the user to bother to put the money back into the machine? The user has won the gamble. The user has the tee shirt for free and can just walk away a winner. The patent teaches placing money into the tee shirt but indicates that it can be any sum of money, not

limited or required to be the sum of money initially placed into the vending machine to obtain the promotional item; another express teaching of gambling in the patent.

THE PRODUCT

The KAUFMAN product may be a beverage, a box of soap or anything, even a snack. However, the product is not attached to the promotional item by a retaining device. KAUFMAN shows the product to be retained together for purposes of loading the vending machine but the product is vended one at a time with no one-to-one vending of the promotional item as KAUFMAN expressly teaches loading the vending machine with a ratio between 1-100 to 1-5 of the promotional items to product items.

Applicant's Attorney's view on BECKMAN

The Beckman patent application is an application for a product that uses;

- 1) A filled beverage bottle;
- 2) A filled snack package; and
- 3) An envelope to attach said filled snack package to said filled beverage bottle as a unit to be placed into an existing vending machine to be dispensed as a unit in a single transactional step.

The KAUFMAN apparatus/process does not teach dispensing the product AND the promotional item as a unit in one transactional step. The teaching is a two step process.

KAUFMAN does not teach:

- 1) Using a binding device to make the promotional item and the product a unit to be dispensed upon the activation of the dispensing mechanism of the vending machine;
- 2) Requiring the use of a filled beverage container; or
- 3) Requiring the use of a filled snack container;

But Kaufman does teach gambling in the process of using the teaching of the patent.

For all the reasons set forth above, Applicant's attorney respectfully requests examiner to withdraw KAUFMAN as a proper prior art to the Beckman/Perez process application.

BECKMAN is a product patent application by a single inventor, James Beckman.

The present BECKMAN/PEREZ process application is an application by co-inventors, James Beckman and Paul Perez.

Applicant's attorney believes it is improper to cite as prior art the application of a co-inventor to deny claims presented in an application by co-inventors when at least one co-inventor is not an applicant of the prior art. This, Applicant's Attorney respectfully requests the Examiner to withdraw BECKMAN product patent application as proper prior art to the present application.

Applicant's Attorney's view on Singer.

Singer is applied to only the cap of a filled beverage bottle which is one item of multiple items with limitations not addressed by Singer. Further, as KAUFMAN does not use a filled beverage bottle there is no need for a cap.

INVENTIVENESS OF BECKMAN/PEREZ PROCESS

As shown above and in the remarks below, the inventive idea of the present application is to substantially increases the earning power of an existing vending machine without modification to the machine by adding product to the existing unused space within the vending machine. The process of assembling a filled beverage bottle and a filled snack package secured by a retaining device either preprocessed and

brought to the vending machine or the assembly is performed in real time during the maintenance of the vending machine is not disclosed by any prior art.

Kaufman actually decreases the income by taking up existing space with a promotional device in an attempt to attract users.

Beckman describes a product but does not teach a process of how to use the product to increase the income of a vending machine.

REMARKS

The examiner has cited KAUFMAN (US 6,247,612) as prior art. The examiner initially contends on page 1, last paragraph that KAUFMAN discloses a process for assembly and the dispensing of a refrigerated beverage container wherein -CONT. ON PAGE 3 of the Office Action - , transporting filled and capped beverage containers (Figure 5) AND (EMPHASIS ADDED) preconfigured products to a site of said vending machine for the purpose of performing maintenance function (loading the containers) of said vending machine (Col.4 line 65-Col. 5 line 10).

Applicant's attorney respectfully traverses the examiner's contention that Figure 5 shows a filled capped beverage containers as the scale of Figure 5 is too small but Figure 5 does nominate the item as 240 which Figure 6 clearly shows is a beverage bottle that is first split into two pieces and then stuffed with a T-shirt with no room for a beverage or a snack.

The Examiner further contends that KAUFMAN shows a product and a prize dispensed "as a unit" (page 3, line 7 of the office action) and again "as a unit with a retaining device" (page 3, line 11, of the office action).

Yet again on Page 3, line 19 of the office action the Examiner contends that the selected dispensed item is a "unit of a combined beverage container and article container thereafter said beverage and article being easily removed from said consumer accessible area (28) as a unit (Figure 10)...

Applicant's attorney respectfully traverses Examiner's characterization of Figure 10 in that Figure 10 clearly shows two halves of an empty beverage bottle 252 that was cut into items 252 a and 252 b into which a T-shirt 242 was stuffed, the two half beverage bottles being held together with retaining device 256 representing ONE ITEM to be dispensed from the KAUFMAN vending machine.

The form applicant's attorney is using in this response is repetitive but the examiner repeats the same assertion that KAUFMAN dispenses a "UNIT" of two items held together by a retaining device when upon careful reading of KAUFMAN what is dispensed are TWO HALFS of an empty beverage container 252 stuffed with a T-shirt 242, the two half bottles 252 a and 252 b Banded with a retaining device so that the ONE item of a T-shirt occupying the entire inside of an empty beverage bottle may be safely dispensed from a vending machine.

The examiner further contends that the free T-shirt is provided "ALONG" this beverage container with a snack product, (Page 4, line 7, of the office action). A true reading of KAUFMAN demonstrates that the T-shirt is stuffed INTO the empty beverage container under sever pressure and may contain money or a coupon within the T-shirt. There is no room for a snack and common sense indicates that the empty beverage bottle stuffed with a T-shirt is not refillable with a beverage. (As an aside the T-shirt is not along but IN the empty beverage container which cannot hold a beverage because KAUFMAN teaches cutting the empty beverage container in half.)

The examiner still further contends on page 4, lines 1-2 that the dispensed device is retrieved from the consumer accessible area 228 so that the consumer may remove the retainer device 256 as shown in Figure 8 (HOWEVER FIGURE 8 does not have an item 256) whereafter the device is ready for the consumption of said beverage and article. However, Figure 8 shows two half beverage bottle units 252 a and 252 b surrounding a T-shirt. No beverage or snack is depicted in Figure 8. The split bottle is incapable of holding a beverage and being filled with a T-shirt there is no room for a snack.

On Page 4, Regarding to claims 2, 5, and 6, the examiner contends that KAUFMAN could be modified such that the assembly of the beverage and the promotional items is performed at the site of the vending machine. However, Kaufman expressly teaches that the assembly of the promotional item requires substantial pressure (page 4, lines 23-29) to form the T-shirt so that it fits into the two parts of the empty beverage bottle. Applicant's attorney contends that transporting a machine that is capable of exerting substantial pressure to the site of the vending machine in order to assemble the T-shirt dispensed unit which again is incapable of holding a beverage as the bottle is split and incapable of holding a snack as it is filled with a T-shirt which covers the balance of the paragraph on Page 4 of the Office Action reference.

Applicant's attorney respectfully traverses the examiner's characterization of the product item installed in the KAUFMAN vending machine as a UNIT equivalent to the combination taught by BECKMAN product. KAUFMAN clearly shows the dispensed items to be a single, individual "empty" container (Fig. 10) stuffed with a promotional item such as a T-shirt. KAUFMAN does not combine a filled beverage bottle with any other item as taught by the BECKMAN application.

The specification of KAUFMAN does not teach using a snack product. The teaching of KAUFMAN is to use an EMPTY (emphasis added) beverage container item 240, page 6 - lines 39-45 which is cut in half and into in which the T-shirt (the promotional item is packaged). A retaining device 256 is used to hold the cut empty beverage bottle back together so that the T-shirt does not fall out. Thus, KAUFMAN does not dispense a FILLED beverage or a FILLED snack as the container is filled with a T-shirt. The binding element 256 taught by KAUFMAN is used to hold the cut, empty beverage container together after the two cut parts of the empty beverage bottle have been stuffed with the T-shirt and money or coupon. After the empty beverage bottle is stuffed, no other item is attached to the T-shirt filled container such as a filled snack package.

The contention of the Examiner that the KAUFMAN container contains BOTH A T-SHIRT AND A SNACK PRODUCT is incorrect as shown by the KAUFMAN patent. The specification of KAUFMAN describes the promotional item 240 as comprised of "an empty product container" (page 6, line 39) which is cut into two pieces and filled with a compressed fabric article 242 (page 6, line 26) and a product label 256 (page 6, line 53) which may be in the form of a retaining device to hold the two empty beverage bottle parts together so that a T-shirt stuffed under extreme pressure into the empty bottle half's may be secured therein.

Figure 10 cited by the examiner is not a UNIT of a filled beverage container and a filled snack container configured as a unit with a retaining device 256 but simply the two half, empty beverage container pieces, now filled with a T-shirt are RETAINED

around the T-shirt with the retaining device 256. KAUFMAN'S two half containers and a retaining device do not constitute a UNIT of a filled beverage bottle and a filled snack package to be released and dispensed into the consumer accessible area as a unit of a combined beverage container and article container as contended by the examiner in the office action on page 3, lines 18 - 20.

The examiner contends that the KAUFMAN machine is loaded with containers configured and assembled as a unit (Col. 4 line 65- Col. 5 line 10). Applicant's attorney respectfully, strongly traverses examiners contention as the storage compartment 30 of the item dispensing machine 20 is separately loaded with at least one promotional item 40 and a string of product 50 items, the number and arrangement of which are determined by the person loading the machine BUT at a ratio between 100 to 1. Thus, clearly there is no correspondence of a promotional 40 and one product 50 item, if the promotional item is received, the user must insert money and select again to receive the product 50. There is no teaching in KAUFMAN that the product 50 is attached to the promotional 40, should the promotional item appear in the dispensing area instead of a product item (as they are dispensed separately) in a two step dispensing process requiring the user's intervention of opening the promotional 40 item in the interim of obtaining the product 50 item. Beckman teaches binding the filled beverage bottle and the filled snack package together as a unit with a retaining device to be dispensed in a one step process with increased price point for the combination beverage and snack so that the price point can be above the price point for the beverage alone.

As the KAUFMAN container is already filled with a T-shirt there is no room for a snack product in the container. KAUFMAN teaches adding money in an indeterminate amount (gambling) or a coupon to the T-shirt (Page 4, line 60) but not a snack.

On page 4, line 13 of the office action, the examiner refers to the assembly of the beverage and the promotional items at the site of the vending machine instead of being preconfigured... However, this statement appears to continue the examiner's belief that KAUFMAN teaches use of a filled beverage container and some other item that can be attached to the beverage container with a retaining device. In fact the examiner expressly concedes on page 4, lines 3-4 of the office action that KAUFMAN does not disclose the dispensed item as being comprised of a beverage "and" a snack. KAUFMAN does not teach the use of a beverage bottle filled with a beverage other than a single dispensed product mention anywhere the use of a filled snack container.

BECKMAN/PEREZ process is the only source of teaching of assembly of a unit comprise of a FILLED beverage bottle and a FILLED snack package held together with a retaining device. KAUFMAN EXPRESSLY TEACHES AWAY FROM USING A BEVERAGE BOTTLE FILLED WITH A BEVERAGE. Filling of the empty beverage bottle of KAUFMAN with a T-shirt requires machinery that compresses the T-shirt to a shape and size under substantial pressure (page 4, lines 23-29, of the KAUFMAN patent, to be stuffed between the two half empty beverage bottle halves and could not be assembled at the site of the vending machine but must be preassembled.

In the office action, page 5, Regarding claims 7, 10 25 and 26, in lines 1-2 of the office action, the examiner contends that KAUFMAN discloses all claimed limitations of BECKMAN/PEREZ process but as shown above KAUFMAN does not disclose a

filled beverage bottle attached to a filled snack package.

Likewise in the office action page 5 lines, 18-19, the examiner's contention that KAUFMAN in view of BECKMAN, product, discloses all of the limitations of BECKMAN/PEREZ process, claim 8 cannot be supported. Kaufman does not claim a beverage cap as a cap on a bottle which is empty, cut in half and stuffed with a T-shirt. The empty product container does not require a cap as it is held together by a retaining device.

Thus, applicant's attorney respectfully requests the examiner to withdraw KAUFMAN as applicable prior art to BECKMAN/PEREZ which requires a filled beverage bottle and a filled snack package be assembled, as a unit with a retaining device, and dispensed as a unit from the vending machine.

The examiner has cited BECKMAN (US 2005/0118309A) as prior art. The co-applicants listed in the present application are Paul Perez and Mark Beckman. As the applicants are different from the BECKMAN single applicant for US 2005/011839A, applicant's attorney respectfully requests the examiner to withdraw BECKMAN as prior art to this pending application.

As both KAUFMAN and BECKMAN should be withdrawn as proper prior art to be applied to the present BECKMAN/PEREZ application the application should proceed to allowance.

On page 5 of the office action, the examiner discusses claims 7, 10, 25 and 26.

The Examiner states that KAUFMAN discloses all claimed limitations of claim 7 however KAUFMAN does not disclose a limiting disk as a retaining device beverage cap. The true reading of KAUFMAN is that there is no element in KAUFMAN claimed to be a cap. There is no need to cap an empty beverage bottle required in the KAUFMAN specification on page 6, lines 39-52. The Examiner continues the rejection by using the limiting disk of BECKMAN as an obvious modification of KAUFMAN by attaching a limiting disk to the beverage cap of KAUFMAN to effectively retain the snack article attached to the beverage container. KAUFMAN has no such snack package.

Applicant's attorney respectfully traverses the examiner's analysis of KAUFMAN. First, KAUFMAN does not claim a cap for the beverage bottle. A cap is unnecessary for KAUFMAN as KAUFMAN uses an empty beverage bottle. Second, KAUFMAN does not claim to have a snack that requires being retained to the cap of the beverage bottle. The "snack" of KAUFMAN is a T-shirt stuffed inside the empty beverage bottle and the bottle is held together by a retaining device 256 so that the T-shirt which occupies all of the inside of the empty beverage bottle does not fall out. KAUFMAN does not disclose a snack of any form and thus lacks the requirement to retain a snack to, along or inside the beverage bottle and there for teaches away from using the retaining device 256 in conjunction with a snack.

Applicant's attorney respectfully requests the examiner to withdraw KAUFMAN as proper prior art.

The present applicant, BECKMAN/PEREZ, has created an invention which utilizes what was previously unused, non-income producing individual original product space in a vending machine to accommodate an additional product, preselected to enhance the original product and thus allow the price for the combination of the original product and the enhancement product to be increased. It is

this inventive step that allows an existing vending machine to experience greater income without any modifications to the existing vending machine. As an example, if the original product was a bottle of COKE ® a bag of peanuts could be chosen as the enhancing product to be dispensed from the same space of the vending machine. As the user is obtaining both the bottle of COKE and a bag of peanuts upon the deposit of the required price and selection of one item in a single transaction, it is appropriate to increase the price of a COKE alone from the vending machine. The key is to take advantage of the shape of the COKE bottle 's narrowing neck beverage bottle which leaves space in the vending machine pigeon hole, individual product space, around or over the neck , as in the example above, the bag of peanuts. A restraining device is employed to keep the bag of peanuts intimately contacting the beverage bottle of COKE while the combination is loaded into the vending machine pigeon hole and subsequently navigates the route from what was the individual product space to the dispensing tray to be retrieved by the buyer.

The size, shape of the additional product and the restraining device are preselected so that the combination of the original product, the additional product and the restraining device fit into the existing original product space whereby the existing vending machine does not require any modification to perform the functions of storage and dispensing the original product as enhanced with the additional product.

As the combination adds value to each and every storage space within the existing vending machine and the combination allows the price point for each space to be increased, the existing vending machine experiences a substantial increase in income without any modification to the vending machine.

Nothing in the prior art discloses the use of this previously unused vending machine space around the neck or over the cap of a beverage bottle vending machine to increase income.

The Examiner has cited KAUFMAN as prior art and contends that KAUFMAN performs the same or similar function of the BECKMAN/PEREZ invention.

Upon careful reading the KAUFMAN vending machine operation is shown to teach the replacement of at least one of the existing product spaces with a promotional item. This space replacement removes this at least one product from the vending machine thus decreasing the income from the vending machine by at least one product price which is contrary to the teaching of the BECKMAN/PEREZ invention. Further, the operation of KAUFMAN teaches placing money into the, at lease one. promotional item in a sum that would be required to purchase the existing product. Should this promotional product be dispensed, the vending machine has lost the income from the space taken up by the promotional product and may have lost the money incorporated into the promotional product. The result is twice the decrease in income using the KAUFMAN invention.

As KAUFMAN teaches away from BECKMAN/PEREZ as demonstrated above, KAUFMAN should be removed as proper prior art and BECKMAN/PEREZ should be found allowable.

A request for an extension of time to file this response is respectfully submitted. The Fee is paid by deposit account for three months extension for a small entity.

Sincerely,

/s/John E. Halamka

John E. Halamka
Attorney of Record
310-541-8290